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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,375	07/10/2001	Martin S. Niles		8831

7590 05/19/2004

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White Plains, NY 10601

EXAMINER	
FULLER, ERIC B	
ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/902,375	NILES, MARTIN S.	
	Examiner	Art Unit	
	Eric B Fuller	1762	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-29,31-39 and 41* is/are pending in the application.

4a) Of the above claim(s) *16-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-29,31-39 and 41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-29, 31-39, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Lacourciere (US 4,943,448).

Lacourciere teaches a process where a high voltage power line and potential grounding source is spray coated with a dielectric material such that prevents small animals from creating short circuits (column 1, lines 20-35; column 3, lines 30-55). The limitations of evaluating the voltage potentials, determining the desired insulating capability, and selecting an appropriate dielectric material are read upon in column 3, lines 10-64. The coating is applied as the power lines are electrified (column 2, lines 1-4). The applicator system is portable (column 13-17). The coating is a liquid as it is applied (column 2, lines 45-55). The coating is applied to both the electrified power line and to the support structure (column 2, lines 18-22; column 9, lines 59-65). The power line is uninsulated prior to the coating step. The use of CARBOLINE #1601 (column 9, lines 47-55) reads on a plurality of dielectric materials making up the coating, see material data sheet provided herewith. Although the liquid material is somewhat conductive due to the solvent (column 4, lines 15-30), since it is explicitly taught that the

application means do not introduce a ground source or an electrical potential to the system such that application is performed safely on live wires (column 2, lines 43-55), this reads on the liquid form have "suitable insulating strength" for safe application.

Response to Arguments

Applicant argues that Lacourciere fails to teach that the material be applied "in liquid form". This is not found persuasive. Column 2, line 49, explicitly teaches a "liquefied coating material". This reads on being applied in liquid form. Applicant argues that the "liquid form dielectric material" of the present invention is patentably distinguishable from a "liquefied solid dielectric material". Examiner disagrees. The claims read to apply the dielectric material in a liquid form. The solid dielectric material of Lacourciere is liquefied and sprayed. By definition of "liquefied", this reads on the applicant's claims. The claims do not exclude the dielectric material being a solid prior to being a liquid. Whether or not the dielectric material was a solid at some point prior to application is not pertinent to the claims as written.

Applicant argues that the claims do not require the dielectric material be electrically isolated from the application system. This is not found convincing. The claims do not exclude such a configuration and are open to comprising such. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Lacourciere fails to teach that the dielectric material has "suitable insulating strength" in liquid form to allow for safe application. This is not found convincing. "Suitable insulating strength" is a relative term allowing for various degrees and conductivity/insulative properties. The degree of insulation required by the claims is only that in which the coating process used can be performed "safely", which is also a relative term. The coating process of Lacourciere is performed safely. Therefore, the dielectric material of Lacourciere must inherently have an insulating strength that is suitable for operating the coating process safely. This reads on the applicant's claims. The additional process steps of Lacourciere, which the claimed invention is open to, allows for the spray material to have more conductivity while still having "suitable insulating strength" to allow for safe application. Additionally it is noted that it is the solvent of Lacourciere that possesses some conductivity (although not enough for the process to be unsafe), not the dielectric material. The claims read that the "dielectric material" has suitable insulating strength. The dielectric material of Lacourciere has excellent insulating strength. This reads on the applicant's claims.

As to claim 33, applicant argues that Lacourciere fails to teach a "plurality of liquid dielectric material components". This is not found persuasive. Lacourciere explicitly teaches a plurality of dielectric components that are liquefied. The claims do not exclude the dielectric material being a solid before being a liquid. Therefore, the plurality of liquefied dielectric components read on the applicant's claims.

Arguments to claim 41 parallel those above for the allegation of Lacourciere failing to teach "suitable insulating strength". This is not found convincing for the reasons given above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (571) 272-1420. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck, can be reached at (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBF

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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700